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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,099	01/16/2002	Keizaburo Matsumoto	020043	5715

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,099

Applicant(s)

MATSUMOTO, KEIZABURO

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The objection is withdrawn. The 112 rejections are withdrawn due to Applicant's amendments.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1 and 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,833,486 to Zerillo for reasons of record as previously set forth in Paper No. 4.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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3. Claims 1-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,245,421 to Aurenty et al. in view of USPN 6,541,567 to Riku et al. for reasons of record as previously set forth in Paper No. 4.
4. Claim 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,245,421 to Aurenty et al. in view of USPN 6,541,567 to Riku et al. and further in view of USPN 6,509,085 to Kennedy for reasons of record as previously set forth in Paper No. 4.
5. Claim 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,245,421 to Aurenty et al. in view of USPN 6,541,567 to Riku et al. and further in view of USPN 5,367,026 to Okude et al. for reasons of record as previously set forth in Paper No. 4.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 6, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner believes that independent claims 1, 6, 7, and 8 (amended) do not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion of 1) an ink *layer* and 2) a receiving layer over an ink layer and/or oil-based ink containing fixed information, although referred to poorly. The ink layer was originally presented as print film which terms may not be used interchangeably.

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According to Applicant's disclosure on page 9, "when the receiving layer is formed on the entire surface of a printed matter or on the printing ink film of the printed matter even in the case that the receiving layer is formed partially on the printed matter, the receiving layer preferably has a smooth continuous surface and preferably is as transparent as possible so as not to conceal printed images. Further, the receiving layer as described is only formed on printed matter or printing ink film. Also on page 11, the specification discloses the following, "wherein the receiving layer is formed at least on the print film of the ink used for printing the fixed information. The printed matter according to item (6), wherein the fixed information is printed with an oil-based ink and the receiving layer is formed at least on the print film of the oil-based ink." Again, the receiving layer is on the film not an ink layer. Hence, the instant claims lacks support as originally filed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Instant claim 1 does not disclose where the receiving layer is in relation to the ink layer, and therefore the claim does not make sense. It appears claims are to two unrelated layers. Instant claim 6 does claim a receiving layer above an ink receiving layer. The Examiner suggests including the limitations of claim 6 in claim 1 for further clarity.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. The limitation, "receiving layer comprising ink absorbing resin as its main ingredient is a receiving layer" is confusing. What does this mean?

Response to Arguments

8. Applicant's arguments filed 11-13-03 have been fully considered but they are not persuasive. Applicant alleges Zerillo does not provide the instant invention because Applicant believes there exists no ink receiving layer. However, the Examiner, as previously set forth, stated Zerillo discloses including a graphic/text image (ink containing fixed image) over a plate (ink receiver). The plate functions as an ink receiving layer because it receives ink.
9. Applicant alleges the Examiner considered the thermoplastic image layer to be equivalent to the ink layer containing fixed information and therefore the printing plate would have no ink receiving layer. The Applicant appears to misinterpret the claim. Instant claim 1 merely calls for a receiving layer and printed fixed information as an ink layer. Aurenty provides such layers. See the abstract, col. 4, lines 5-40. Applicant further argues that in the lithographic printing plate, the ink receptive image layer functions as an image area to which printing ink is attached. Such argument is evidence that ink is received and therefore a receiving layer is present, (e.g. "to which printing ink is attached"). Applicant further argues when ink is delivered and to what sections ink appears during a lithographic process. Such limitations are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., when ink is delivered and to what sections ink appears during a lithographic process) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As previously set forth, both layers receive ink and therefore are considered ink receptive, functioning as having a receiving layer and both layers (thermoplastic image layer and hydrophilic porous layer) comprise very little percentage of other additives are therefore considered to have the main ingredient in each layer. See Col. 3, lines 9-10, col. 4, lines 20-32, col. 5, lines 10-20, col. 5, lines 65-68 and col. 6, lines 14-25. Further to the ingredient in the ink-receiving layer containing an ink-fixing resin, Riku was used to teach this aspect at col. 9, lines 25-38. Applicant argues that both the hydrophilic and thermoplastic image layers are equivalent to the ink receiving layer set forth in claim 1. The Applicant refers to an ink receiving layer in claim 1 and two ink receiving layers in claim 2, which Aurenty provides for. Applicant argues therefore that the plate would have no ink layer with information, further arguing the layers of Aurenty do not function as non-image areas and there is no room for a layer to be considered an ink layer with fixing information. As claim 2 reads, receiver layers contain two different resins, respective to the two receptive layers. Aurenty provides for these two layers as aforesaid. Again see col. 4, lines 20-32, col. 5, lines 10-20 and 46-60, col. 5, lines 65-68 and col. 6, lines 14-25.

10. Applicant argues that Riku doesn't disclose an ink receiving layer and ink layer. However, Aurenty was used to teach these layers. Riku, as aforesaid, was used to teach the ink-fixing resin. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

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5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Aurenty and Riku teach ink fixing technologies and are therefore analogous art as previously set forth.

11. Applicant argues that claim 11 recites a proper additional limitation over claim 7, addressing a wet condition of a printed surface. Intermediate processes steps are not germane to patentability in product claims. The end product is claimed and Aurenty and Riku provide for the materials and same processes as Applicant and therefore any property or stage that follows from that is inherent. See col. 2, lines 60-68 of Aurenty to the in-line process.

12. Applicant contends Kennedy does not teach printed matter as instant claim 1 recites. However, the Examiner did not use Kennedy to teach printed matter, but to teach the method of printing using anilox and rubber layers on substrates including ink jet ink. See Kennedy col. 3, lines 43-65 and col. 5, lines 61-68.

13. Applicant argues Okude does not teach the coating formula of instant claim 8 along with printed matter and paper substrates. As acknowledged by Applicant, Okude provides the coating formula applied to plastic substrates as Aurenty applies to the same plastic substrates. The same application techniques for coatings as applicant are provided by Okude. Aurenty was provided to teach paper substrates as well.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Tamra L. Dicus
Examiner
Art Unit 1774

January 21, 2004

RECEIVED
SUPERVISOR
JAN 21 2004

Cynthia Kelly